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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,657	07/07/2003	Kevin Thomas Stone	5490-0187DVA	7538
27572	7590	12/13/2005	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			SHAFFER, RICHARD R	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/614,657	STONE ET AL.	
	Examiner Richard R. Shaffer	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 November 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
  - 4a) Of the above claim(s) 5-9 and 14-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 and 10-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 July 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/7/2003</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Election/Restrictions***

Applicant's election with traverse of **Group I**: Claims 1-17, classified in 606/105 and Species VI (Figure 9) in the reply filed on November 17<sup>th</sup>, 2005 is acknowledged. The traversal is on the ground(s) that the independent claims could be classified in the same class and subclass and that the searches are the same, and thus does not present a burden to the examiner. This is not found persuasive because although they are classified in the same class and subclass, it does not mean they have the same search. Claims 1-17 could read on balloons attached to each other, a necklace, or as demonstrated in this rejection a device for removing dents in musical instruments. The examiner would have had no motivation for searching such classes for the method (claims 18-20) for separating two articulating surfaces of a joint.

The applicant further traversed the election of seven distinct species shown in **Figures 1, 4, 6, 7, 8, 9, and 10** asserting that the previous examiner stated two species, that there is a disclosure tying species together, and that there are a reasonable number of species. This is not found persuasive because the current case is an independent case and the species specified are present and disclosed in the application according to the brief description of the drawings. It is also found appropriate because although there might be a relationship between the species, it is of no consequence. Species are mere embodiments of an invention. By having generic claims, they clearly are related. It is also the examiner's opinion that having seven distinct species is not having "a reasonable number of species."

It is acknowledged that applicant believes that claims 1-17 read on the elected **Species VI** shown in **Figures 9, 11, and 12**. The examiner disagrees with applicant. As written in the disclosure of the application (see brief description of drawings), **Figures 11 and 12** are views of the embodiment of **Figure 10 (Species VII)**. Thus, clearly the embodiment for **Species VI** is only shown in **Figure 9** and it would be treated as such for examination purposes. Claims 5-9 and 14-17 recite the limitations "flat surface," "parallel surfaces," and "thickness" for between the parallel surfaces, which are all directed towards **Species VII**. **Species VI** does not have a flat surface and thus does not have a thickness between surfaces, but rather a diameter.

Claims 5-9 and 14-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 17<sup>th</sup>, 2005.

The requirement is still deemed proper and is therefore made **FINAL**.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferree (US Patent 4,727,744). Ferree discloses a device (**10, Figure 3**) comprising an articulating member having a proximal, distal end and cord (**28, Figure 2; no ref**

**Figure 3); a handle (24) disposed at an end; a plurality of spheroidal members (56, 58, 60, 62) having a plurality of diameters increasing from the proximal end to the distal end; and the spheroidal members coupled to the articulating member.**

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday during (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Shaffer  
December 9<sup>th</sup>, 2005



EDUARDO C. ROBERT  
PRIMARY EXAMINER